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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/603,250

06/25/2003

John T. Ulman

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08/02/2006

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EXAMINER

BOGART, MICHAEL G

ART UNIT

PAPER NUMBER

3761

DATE MAILED: 08/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/603,250

Applicant(s)

ULMAN, JOHN T.

Examiner

Michael G. Bogart

Art Unit

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-11 and 17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-11 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Withdrawal of Allowability

The indicated allowability of claim 17 is withdrawn in view of the newly discovered reference(s) to Hines *et al.* (WO 97/41818 A1; hereinafter "Hines"). Rejections based on the newly cited reference(s) follow.

Specification

The specification at page 13, line 20, uses the reference number 107 to indicate the transfer layer. Elsewhere in the specification and drawings the transfer layer is indicated by reference number 99.

Claim Objections

Claims 4 and 7 are objected to because of the following informalities: Claim 4 recites the limitation "the single side of the longitudinally-extending centerline" in lines 4 and 5. There is insufficient antecedent basis for this limitation in the claim.

In claim 7, line 2, after "surface", insert --of--.

Appropriate correction is required.

Claim Rejections – 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 3761

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 3-5, 7, 8, 11 and 17 are rejected under 35 U.S.C. § 102(b) as being anticipated by Hines *id.*

Regarding claim 17, Hines teaches a sanitary napkin (20) comprising:

a main body (22), the main body (22) comprising a fluid-permeable cover layer (44), a liquid-impervious barrier layer (46) and an absorbent system (48) intermediate the cover layer (44) and the barrier layer (46), wherein the main body (22) comprises a front portion (32), a rear portion (34) and a center portion (36) intermediate the front portion (32) and the rear portion (36), and wherein the front portion (32) extends laterally to at least one outermost front distal point (40) and the rear portion extends laterally outward to at least one outermost rear distal point (40); and

a side flap (24) projecting laterally outward from the absorbent system (48), extending laterally outward from a proximal edge (74) of the center portion (36) and capable of being folded over a crotch portion of a user's undergarment (10) in use, the side flap (24) extending laterally outward from the proximal edge (74) to a distal end (76), wherein the distal end (76) is not substantially laterally outward from the at least one outermost front distal point (40) and the distal end (76) is not substantially laterally outward from the at least one outermost rear distal point (40), and wherein the at least one outermost front distal point (40), the at least one outermost rear distal point (40), and the side flap (24) are each positioned on a single side of a longitudinally extending center line (L) of the sanitary napkin (20); and

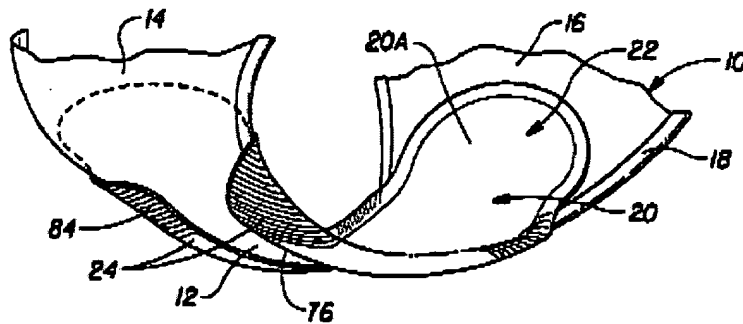
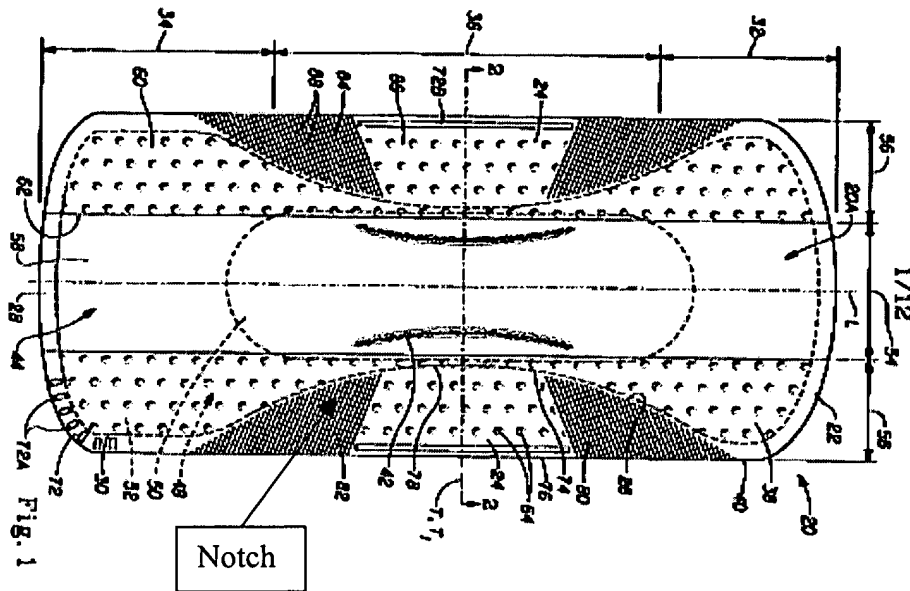
a inherently resilient element (50), said resilient element (50) being separated from the flap by along a hinge line (78)(see figures 1 and 9, below).

“[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art’s functioning, does not render the old composition patentably new to the discoverer.” *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, supra.

There is no requirement that a person of ordinary skill in the art would have recognized the inherent disclosure at the time of invention, but only that the subject matter is in fact inherent in the prior art reference. *Schering Corp. v. Geneva Pharm. Inc.*, 339 F.3d 1373, 1377, 67 USPQ2d 1664, 1668 (Fed. Cir. 2003).

“[T]he PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his [or her] claimed product. Whether the rejection is based on inherency’ under 35 U.S.C. § 102, on prima facie obviousness’ under 35 U.S.C. § 103, jointly or alternatively, the burden of proof is the same...[footnote omitted].” The burden of proof is similar to that required with respect to product-by-process claims. *In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980) (quoting *In re Best*, supra). MPEP § 2112.

In the instant case the absorbent elements described by Hines inherently possess some resiliency.



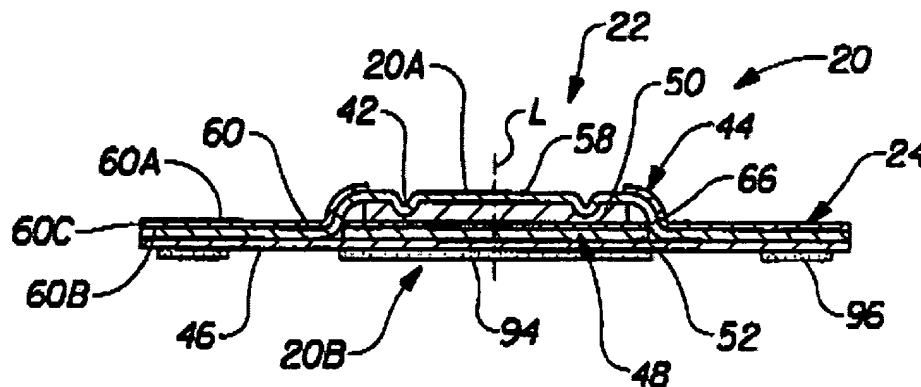
Regarding claims 3 and 8, Hines teaches that the flap (24) is, at least in part, structurally isolated from the front portion (32) by an anterior notch, and the flap (24) is, at least in part, structurally isolated from the rear portion (34) by a posterior notch. As defined herein, the weakened material (84) within the notch makes the flap (24) partially structurally isolated from ends (32, 36). The asymmetric notches are defined as being more acute than 90° angle of the intersection between side flap (24) and proximal edge (74).

Art Unit: 3761

Regarding claim 4, Hines teaches that the side flap (24) projects outward to at least one outermost distal point (76) of the flap (24), and wherein the sanitary napkin (20) further comprises an anterior notch defined by an anterior notch boundary that extends continuously from the at least one outermost front distal points (40) to the at least one outermost distal points (76) of the flap (24), and wherein the at least one outermost distal points (76) of the flap (24) are located on the single side of the longitudinally-extending centerline (L)(see figure 1).

Regarding claim 5, Hines teaches that the anterior notch boundary includes portions that are laterally inward from the outermost front distal point (40)(figure 1).

Regarding claim 7, Hines teaches a flap positioning adhesive (96) on the bottom surface of the liquid impervious barrier layer (46)(figure 2).



Regarding claim 11, Hines teaches a cover layer (44) and barrier layer (46) which each extend homogeneously across the proximal edge (74) from the main body (22) to the flap (24).

Claim Rejections – 35 USC § 103

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9 and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hines.

Hines does not provide specific dimensions for the notch depth or span.

Mere modification of the relative size of something in the prior art is not sufficient to patentably distinguish a claimed invention from the prior art.

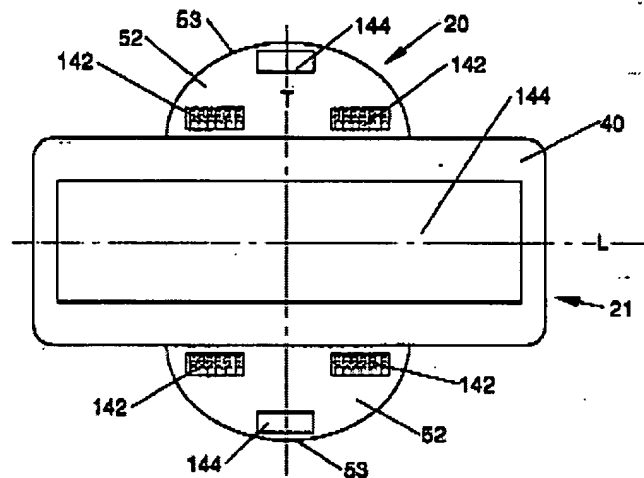
In Gardner v. TEC Systems, Inc., 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. MPEP § 2144.04.

In the instant case, the claimed dimensions do not appear to be critical, nor is there an unexpected result shown from these specific dimensions.

Claim 6 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Hines as applied to claims 3-5, 7, 8, 11 and 17 above, and further in view of Osborn, III *et al.* (US 5,611,790 A; hereinafter (“Osborn”).

Hines does not teach side flaps that are free of adhesive.

Osborn teaches a sanitary napkin (20) that employs flaps (52) with hook and loop fasteners (142)(figure 44).



At the time of the invention, it would have been obvious to replace the adhesive fasteners of Hines with the mechanical fasteners of Osborn in order to provide art recognized equivalents for attaching to undergarments.

Response to Arguments

Applicant's arguments with respect to claims 3-11 and 17 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bogart whose telephone number is (571) 272-4933.

In the event the examiner is not available, the Examiner's supervisor, Tatyana Zalukaeva may be reached at phone number (571) 272-1115. The fax phone number for the organization

Art Unit: 3761

where this application or proceeding is assigned is (571) 273-8300 for formal communications.

For informal communications, the direct fax to the Examiner is (571) 273-4933.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-3700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Michael Bogart
28 July 2006

TATYANA ZALUKAEVA
SUPERVISORY PRIMARY EXAMINER

